



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/471,890	06/07/1995	DONALD R. HUFFMAN	7913ZY	9010

7590 08/18/2004

LEOPOLD PRESSER
SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER

HENDRICKSON, STUART L

ART UNIT PAPER NUMBER

1754

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 08/411890	Applicant(s) Huffman
Examiner H. Adickson	Group Art Unit 1151

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11/03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 8988-93, 95-106 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 8988-93, 95-106 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1754

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The Notice of Abandonment mailed 6/22/04 is withdrawn; the error is regretted. As this was an error on the art of the Office, no petition or fees are due. The request filed on ca. 1/10/03 for Continued examination (RCE) based on parent Application No. 08/471890 is acceptable and has been established. An action on the RCE follows.

Claims 89-93, 95-106 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 45-77, 79-180 of copending Application No. 07/580246. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both claim macroscopic amounts of C60 and C70 fullerenes. No difference is seen between the two applications in the amounts and kind of carbon made; it is not seen how different carbons would result therefrom. The similarity of the two sets of claims is self evident.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 89, 93 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A) Claims 89 and 93 recite 'macroscopic' amounts of the material, but the original specification does not support this. The discussion on pgs. 5-8 of the prior office action are referred-to and incorporated.

Art Unit: 1754

Claims 89-92 and 95-106 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kroto/Nature November 14, 1985, with the Curl/Scientific American cited to show a state of fact.

Applicant is referred to the rejection in the prior office action, incorporated herein by reference.

Claims 89-93, 95-106 are rejected under 35 U.S.C. 102(b) as being anticipated by the Kratschmer article "Spectroscopy ... Cluster Molecules".

Applicant is referred to the rejection in the prior office action, incorporated herein by reference.

No difference is seen in the carbon formed, nor in the amounts thereof.

Applicant's arguments filed ca. 1/10/03 have been fully considered but they are not persuasive.

Papers which are already of record should not be resubmitted. They have been addressed, either in previous actions or by the Board of appeals. The alleged evidence in paragraph 19 of the Loutfy Declaration of 7/16/02 is not persuasive since the source is the same as the applicant, so it is biased. It is irrelevant in view of the additional such characterizations from unbiased sources, indeed provided in the PTO action. Arguments in previous office actions are incorporated herein by reference. Support for 'fullerenes' does not equate to support for 'macroscopic'. The argument that 'macroscopic' is supported is not persuasive in view of the Board Decision in the parent application, discussing this issue at length.

Any inquiry concerning this communication should be directed to examiner Hendrickson at telephone number (703) 308-2539.



Stuart Hendrickson
Primary examiner Art Unit 1754